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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,781

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De-Sheng Tsai

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EXAMINER

COLE, ELIZABETH M

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

11/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/780,781	Applicant(s) TSAI ET AL.	
	Examiner Elizabeth M. Cole	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-24, 26-28 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24, 26-28 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22-24, 34-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki et al, U.S. Patent No. 5,814,569. Suzuki discloses nonwoven fabrics comprising polypropylene conjugate continuous filaments, (spunbonded nonwovens), which are subjected to heating and drawing in order to form elastic nonwovens. See col. 3, lines 11-21, col. 4, lines 16-58. The nonwoven has the properties of 86% recovery from 100% elongation in the cross direction and has a ratio of elongation at break in the cross direction to the elongation at break in the machine direction of at least 8. See table 1 and the values for EC/EM as well as EEC 100%. The drawing treatment is performed at a temperature above the softening but below the melting point of the fibers. See col. 9, line 49 - col. 10, line 53. The draw rate is 10-80% and preferably 40-75%. See col. 11, lines 4-28. Suzuki does not disclose the claimed property of at least 60% recovery from a 150% elongation and does not disclose the claim strain rate. However, it is reasonable to presume that the material of Suzuki would have the claimed property of at least 60% recovery from a

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150% elongation in view of the facts set forth above, that the material of Suzuki comprises polypropylene fibers, that it has the claimed ratio of elongation at break in the CD to the elongation at break in the MD, that is has the claimed recovery from 100% elongation, that is subjected to drawing at the claimed temperatures and at the claimed drawing rate. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention the examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02. Further, with regard to the process limitation of the strain rate, the instant claims are drawn to a product. Product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product - by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe* , 227 USPQ 964, 966 (Fed. Cir. 1985).

Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence

establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983).

The use of 35 USC 102/103 rejections for product by process claim has been approved by the courts. "[T]he lack of physical description in a product - by - process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product - by - process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown , 173 USPQ 685, 688 (CCPA 1972).

4. It is noted that the material of Suzuki would be capable of performing the intended uses of being used in garments, absorbent articles, etc. , especially since no further structure is set forth with regard to these claims. Further, Suzuki teaches at col.1 that such uses were known in the art as conventional for elastic nonwoven fabrics.

5. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki as applied to claims above, and further in view of Morman et al, U.S. Patent Application Publication No. 2003/0100238. Suzuki discloses an elastic nonwoven fabric as set forth above, but does not disclose laminating the nonwoven to additional layers.

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Morman teaches that elastic nonwoven fabrics can be bonded to extensible or elastomeric films to provide laminates. See paragraph 0062-0069. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have bonded the fabric of Suzuki to a film as taught by Morman, in order to form a laminate having the additional properties of the film in combination with the nonwoven, such as improved strength, water barrier properties, etc.

6. Applicant's arguments filed 8/19/08 have been fully considered but they are not persuasive. Applicant argues that the fibers of Suzuki are not polypropylene fibers because they are conjugate fibers which have a polyester core. However, the claims do not recite that the polypropylene fibers consist of polypropylene or are 100 percent polypropylene but instead recite that the web consists essentially of polypropylene fibers. The fibers of Suzuki are polypropylene fibers because they are made of polypropylene.

7. Applicant argues that there is no basis to assume that the material of Suzuki would have the claimed properties of at least 60% recovery from a 150% elongation and does not disclose the claim strain rate. However, it is reasonable to presume that the material of Suzuki would have the claimed property of at least 60% recovery from a 150% elongation in view of the facts set forth above, that the material of Suzuki comprises polypropylene fibers, that it has the claimed ratio of elongation at break in the CD to the elongation at break in the MD, that it has the claimed recovery from 100% elongation, that it is subjected to drawing at the claimed temperatures and at the claimed drawing rate. The presumption is based on the facts which establish that Suzuki

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teaches polypropylene fibers, that it has the claimed ratio of EC/EM, and that it subjected to drawing at the claimed rates and temperatures and that it has the claimed recovery from 100% elongation. Therefore, there is a reasonable basis to expect that the material of Suzuki would have the claimed properties. Therefore, the burden is shifted to Applicant to show that the material of Suzuki does not have the claimed properties.

8. Applicant argues that comparative example 2 of Suzuki does not meet the claimed EC/EM which establishes that the claimed invention which consists essentially of polypropylene fibers is different than what is shown in Suzuki, since in Suzuki the web made of 100 polypropylene fibers does not meet the claimed EC/EM ratio.

However, as set forth above, the instant claims do not recite that the web is made of fibers made of 100% polypropylene but instead recite that the web consists essentially of polypropylene fibers. The conjugate polypropylene fibers of Suzuki are polypropylene fibers.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

The examiner's supervisor Rena Dye may be reached at (571) 272-3186.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

e.m.c